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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,669	05/27/2005	Kazumi Nakayoshi	71,051-009	4704

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EXAMINER	
LOEWE, ROBERT S	
ART UNIT	PAPER NUMBER
1796	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/536,669	NAKAYOSHI ET AL.	
	Examiner	Art Unit	
	ROBERT LOEWE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5,6,8-10 and 17-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *20-29* is/are allowed.

6)☒ Claim(s) *5,6,8-10 and 17-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's amendments to the instant claims requiring that a reaction take place between the silver-based particles and the triazole-based oxidation inhibitor is noted. Support for this amendment can be found at paragraph 0018 of Applicants pre-grant publication 2006/0047043. However, it is the position of the Examiner that the amendments made to claims 5, 6, 8-10 and 17-19 do not remove Fujiki et al. (US Pat. 6,140,446) as a prior art reference. The composition requires a curable silicone resin comprising a silver-based particle which is surface treated with a triazole-based oxidation inhibitor. The limitation "via a chemical reaction" is interpreted as a process limitation; therefore composition claim 5 is interpreted as a product-by-process claim.

Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even thought the prior art product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Please note MPEP 2113, which addresses the appropriateness of a rejection under 35 U.S.C. 102/103 for product-by-process claims.

"The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product

appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289,292 (Fed. Cir. 1983).

Applicants newly added claims 20-29 are not subject to any rejections and are found to be allowable for reasons provided below.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-6, 8-10 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki et al. (US Pat. 6,140,446).

The Examiner has interpreted instant claim 5 to be a product-by-process claim as recited in the response to arguments section above.

Claims 5, 8 and 9: Fujiki et al. teaches a curable silicone composition comprising (A) 100 parts by weight of an organopolysiloxane having at least two alkenyl radicals per polymer chain (4:63-65), (B) an organohydrogenpolysiloxane having from 0.4 to 20 moles of Si-H groups per mole of Si-alkenyl groups of component (A) (4:66-5:4), (C) from 0 to 800 parts of a filler which may be silver powder (7:38-46), (D) a platinum-based catalyst (5:5-8), and (E) an addition reaction retarder, which may include benzotriazole, which is taught to be preferably present from 0.001 to 5 parts by weight per 100 parts by weight of component (A) (7:23-37). Because several different fillers and addition reaction retarders are taught, Fujiki et al. is not believed to anticipate instant claim 5. However, Fujiki et al. renders obvious the composition of claim 5 since Fujiki et al. suggests that the filler may be silver and the addition reaction retarder may be benzotriazole. Also, while Fujiki et al. does not teach that the benzotriazole is added as an oxidation inhibitor, it may nevertheless serve as such. Indeed, the purpose of addition reaction retarders is to prevent the oxidation of the platinum-based catalyst which starts the hydrosilation reaction between the organohydrogenpolysiloxane and the alkenyl-polysiloxane. Thus, the addition reaction retarders serve as oxidation inhibitors.

While Fujiki et al. does not explicitly teach that the silver filler and the benzotriazole undergo a chemical reaction, it is the position of the Examiner that a curable silicone rubber composition which has been prepared by mixing the organopolysiloxane ingredients, silver filler and benzotriazole will inherently result in some level of interaction between the silver filler and the benzotriazole. Applicants are invited to show that silver filler which has been chemically reacted at its surface with a triazole-based oxidation inhibitor would inherently have different physical properties that those compositions in which the silver filler was merely surface-treated

with a triazole-based oxidation inhibitor. For purposes of patentability, product-by-process claims are based on the product itself, and not on its method of production.

Claim 6: The instant specification teaches that the ingredients may be mixed mechanically using a roll mill (4:42-57).

Claim 10: Because Fujiki et al. renders obvious the composition of the instant claims, it follows the Fujiki et al. may be used in the manner as claimed in instant claim 10.

Claim 17: Fujiki et al. teaches that the amount of addition reaction retarder is preferably present from 0.001 to 5 parts by weight per 100 parts by weight of the alkenyl-polysiloxane (7:23-37). Fujiki et al. further teaches that there may be from 0 to 800 parts by weight of filler per 100 parts by weight of component (A). So when the amount of filler and component (A) are at or near equivalency, the amount of addition reaction retarder based on the amount of filler falls within the range of instant claim 17.

Claim 18: Fujiki et al. teaches that from 0 to 800 parts by weight of silver powder may be present and that the amount of addition reaction retarder/oxidation inhibitor is small compared to the amount of silver powder (see claim 17). Therefore, Fujiki et al. also teaches the limitations of instant claim 18.

Claim 19: While Fujiki et al. does not explicitly teach that the silver-based powder is surface-treated with an oxidation inhibitor prior to the introduction into the composition, Fujiki et al. renders obvious the composition of instant claim 5. Claim 19 is a product-by-process claim. Product-by-process claims are based on patentability of the product itself and not to its method of production.

Relevant Art Cited

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

Allowable Subject Matter

Claims 20-29 are allowed. Specifically, none of the prior art of record teaches or renders obvious the claimed method for preparing a curable composition in which a silver-based powder is subjected to mechanical energy in the presence of an organic solution of a phenol-based or triazole-based oxidation inhibitor prior to incorporation of the resultant surface-treated silver-based powder into the curable silicone composition. While Fujiki et al. is believed to render obvious the composition of claims 5, 6, 8-10 and 17-19 as described above, there is simply no teaching or suggestion to prepare the curable silicone compositions in the manner as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./
Examiner, Art Unit 1796
6-May-09

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796